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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/055,637	01/23/2002	Stephen L. Siegler	LAWR0021US	9426

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EXAMINER

FLANDRO, RYAN M

ART UNIT	PAPER NUMBER
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3679

DATE MAILED: 07/16/2003

8

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/055,637

Applicant(s)

SIEGLER ET AL.

Examiner

Ryan M Flandro

Art Unit

3679

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 May 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Terminal Disclaimer

2. The terminal disclaimer filed on 01 April 2003 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of USPN 6,375,164 has been reviewed and is accepted. The terminal disclaimer has been recorded.

Specification

3. Applicant's amendment submitted 05 May 2003 has overcome the Examiner's objections to the abstract of the disclosure and, as such, the objections are hereby withdrawn.

Claim Objections

4. In light of Applicant's amendment submitted 05 May 2003, the Examiner's objections to claims 1, 5, and 8 (see paper no. 2, sections 4(a), (c), and (d)) are hereby withdrawn. Claims 2-6 and 8 are, however, still objected to because of the following informalities:

- a. Claims 2-6, and 8. The word "A" at the beginning of each claim should be changed to "The".
- b. Appropriate correction is required.

Claim Rejections - 35 USC § 112

5. In light of Applicant's Amendment submitted 05 May 2003, the rejections of claims 2-6 set forth in the previous Office action under 35 USC §112, second paragraph, are hereby withdrawn.

Claim Rejections - 35 USC § 102

6. Claims 1, 2, 4, 5, 7, and 8 are rejected under 35 U.S.C. 102(b) as being anticipated by Oster (US 4,844,420).

a. Claim 1. Oster specifically discloses a pedestrian traffic control device **10** comprising a hollow, upright, one piece, post **22,12** having an open upper end and a lower end; at least one slot **24** in the post **22,12** between its ends, the slot **24** being spaced from both ends of the post **22,12**; a cassette **52** located within the post **22,12** and between its ends, the cassette **52** incorporating a tape **18** wound on a spool **30**, the tape **18** being extendable from the cassette **52**, through the slot **24** in the post **22,12**, in a direction generally perpendicular to the axis of the post **22,12**; the lower edge of the tape **18**, when extended, being spaced from the upper end of the post **22,12** at least several inches (see figure 2), and means **32,34,36,22,22a** for holding the cassette **52** within the post **22,12**. (See Figures 1, 2, and 4; column 1 line 62 – column 2 line 64.)

b. Claim 2. Oster further discloses that the post **22,12** and cassette **52** are both generally circular in cross-section, and the outer diameter of the cassette **52**, along its entire axial length, is smaller than the internal diameter of the post **22,12**, so that the cassette **52** can

Art Unit: 3679

be inserted into the open upper end of the post **22,12** and moved to its location between the ends of the post **22,12** (see figure 4).

c. Claim 4. Oster further discloses means **32,34,36,22,22a** for supporting the cassette **52** within the post **22,12** in the region of the slot **24** in the post **22,12** (see figures 2, 2A, and 4; column 1 line 62 – column 2 line 64).

d. Claim 5. Oster discloses the support means **32,34,36,22,22a** includes a tube **22,22a** within the post **22,12** having an upper end in the region of the lower end of the slot **24** in the post **22,12**, the cassette **52** being seated upon the upper end of the tube **22,22a** (see figures 2, 2A, and 4).

e. Claim 7. Oster also shows a method of assembling a pedestrian traffic control device **10**, the device **10** including a hollow post **22,12** having an open upper end and a slot **24** between and spaced from the post **22,12** ends, the lower edge of the slot **24** being spaced from the upper end of the post **22,12** at least several inches, and a cassette **52** incorporating a spool **30** on which a tape **18** is completely wound, the free end of the tape **18** being exposed, the method including the steps of: inserting the cassette **52** into the open end of the post **22,12**, maneuvering the cassette **52** along the length of the post **22,12** until the free end of the tape **18** is accessible through the slot **24** in the post **22,12**; pulling the free end of the tape **18** through the slot **24**; and attaching a finger pull **20** to the free end of the tape **18** exposed outside the post **22,12**, the pull **20** being sized large enough so that the free end of the tape **18**, with pull **20** attached, cannot be retracted into the post **22,12** through the slot **24** (see figure 4).

Art Unit: 3679

f. Claim 8. Oster lastly discloses that the tape-carrying spool **30** is spring biased in a direction tending to wind the tape **18** on the spool **30**, so that pulling the free end of the tape **18** through the post slot **24** adds tension to the spring **28** (figure 4; column 2 lines 45-48).

Claim Rejections - 35 USC § 103

7. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

8. Claims 3 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Oster, as applied to claim 1 above.

a. Claims 3. Oster discloses all of the limitations recited in claim 3 except for the lower edge of the tape, when extended, being less than twenty-seven (27) inches above the floor supporting the post. It would have been obvious, however, to one having ordinary skill in the art at the time the invention was made to move the cassette of Oster to another position wherein the lower edge of the tape is less than 27 inches above the floor since it has been held that rearranging parts of an invention involves only routine skill in the art.

Art Unit: 3679

In re Japikse, 86 USPQ 70 (CCPA 1950) (holding that claims to a hydraulic power press which read on the prior art except with regard to the position of the starting switch were held unpatentable because shifting the position of the starting switch would not have modified the operation of the device). Therefore, positioning the tape at 27 inches above the floor would have been obvious to one having ordinary skill in the art at the time the invention was made.

b. Claim 6. Oster discloses all of the limitations recited in claim 6 except for the pedestrian control device explicitly having no tape-holding cassette occupying the upper end of the post. It would have been obvious, however, to one having ordinary skill in the art at the time the invention was made to move the cassette of Oster from the upper end of the post to another position since it has been held that rearranging parts of an invention involves only routine skill in the art. *In re Japikse*, 86 USPQ 70, (CCPA 1950).

Double Patenting

9. In view of Applicant's submission of a terminal disclaimer on 01 April 2003, the Double Patenting rejections set forth in the previous Office action (paper no. 2) are hereby withdrawn.

Response to Arguments

10. Applicant's arguments filed 05 May 2003 have been fully considered but they are not persuasive.

Art Unit: 3679

- a. First, in response to Applicant's argument that "post 22 and housing 12 [of Oster] are obviously two separate pieces, and not one piece," the Examiner notes that it has been held that forming in one piece an article which has formerly been formed in two pieces and put together, and vice versa, involves only routine skill in the art. *Howard v. Detroit Stove Works*, 150 U.S. 164 (1893). Thus, in the instant case, the Examiner's consideration of elements 22 and 12 as a "one piece post" is justified.
- b. Second, Applicant argues that "housing 12 of cassette 10 cannot possibly be considered a part of post 22, because without housing 12, cassette 10 is no longer a viable unit." The Examiner respectfully disagrees with this argument because the cassette will not be "without" the housing simply because it is considered to be integral with, or part of, the post 22. The housing of Oster, as disclosed, is already fastened to the base member and, in turn, to the post and is thus integral therewith. Placement of the cassette within the housing, even when it is included as part of the post, does not destroy any functionality. Further, the Examiner agrees with Applicant's assertions that the housing serves as a support for top cap 14 and base member 32, between which the spool 30 is rotatably mounted, but maintains that these functions will not be disturbed by consideration of the housing and post as one unit.
- c. Third, in response to Applicant's arguments (see paper no. 6, page 5-6) that Oster fails to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., post not being less than 30 inches, signs mounted to top of posts, etc.) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims.

See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Further, those limitations added to the claims by the recent amendment are addressed in the rejections above.

d. Fifth, Applicant argues that “there is no suggestion in Oster that the cassette be moved to a position spaced beneath the upper edge of post 22.” In response, the Examiner first points again to the fact that the “post” has been construed as including both the post 22 and the housing 12. As such, the cassette is already positioned beneath the upper edge of the post and, as stated in the third full paragraph of Applicant’s amendment, “at a point between its ends.” Depending on the height of the post, it is within the disclosure of Oster to have the lower edge of the tape less than 27 inches above the floor.

e. Lastly, Applicant argues that Oster does not disclose “the lower edge of the slot being spaced from the upper end of the post at least several inches,” as recited in the amended claims. The rejection set forth in section 6(e) above addresses this argument.

Conclusion

11. Applicant’s amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after

Art Unit: 3679

the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The following patents are cited to further show the state of the art with respect to pedestrian traffic control devices:

US Design Patent D455,845 S to Stokes et al.

GB Patent Application Pub 2,360,995 A to Kett et al. (see especially figure 6 and all associated description in the disclosure).

GB Patent Application Pub 2,346,867 A to Vine (see entire disclosure)

GB Patent Application Pub 2,247,095 A to Reading et al.

EP 0287510 A1 to Donnet

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ryan M Flandro whose telephone number is (703) 305-6952. The examiner can normally be reached on 8:30am - 5:30pm Mon-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lynne H Browne can be reached on (703) 308-1159. The fax phone numbers for the

Art Unit: 3679

organization where this application or proceeding is assigned are (703) 872-9326 for regular communications and (703) 872-9327 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.

Ryan M. Flandro
July 11, 2003



Greg Binda
Primary Patent Examiner
Technology Center 3670